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**FAX RECEIVED****FEB 21 2003****GROUP 1600****TELECOPY****PLEASE DELIVER AS SOON AS POSSIBLE.****OFFICIAL****DATE:** February 21, 2003**TO:** USPTO - Group Unit 1616**FROM:** J. Scott Young  
09/601,028 Filed September 18, 2000**BEFORE FINAL ACTION**

Attached is a Request to Withdraw Advisory Action As Improper

**NO. OF PAGES:**  
(Including cover page)

46

**OPERATOR:****IF NOT RECEIVED PROPERLY, PLEASE NOTIFY ME IMMEDIATELY AT****USER CODE:** YOUNS**FAX NUMBER:**

703-872-9306

**CLIENT/MATTER:** 33477/201570**REQUESTED BY:** Tammy Stevens x 1165**VOICE NUMBER:**

Alston &amp; Bird

Received from &lt;7043316090&gt; at 2/21/03 10:41:00 AM [Eastern Standard Time]

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M.M.  
3/27/0Attorney's Docket No. 33477/201570

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Pugh, et al.  
Appl. No.: 09/601,028  
Filed: September 18, 2000  
For: SYNTHETIC BIOMATERIAL COMPOUND

Confirmation No.: 4345  
Group Art Unit: 1616  
Examiner: Robert M. DeWitty

February 21, 2003

Commissioner for Patents  
Washington, DC 20231

## REQUEST TO WITHDRAW ADVISORY ACTION AS IMPROPER

Sir:

In response to the Advisory Action mailed December 18, 2002, the Applicant hereby requests reconsideration and withdrawal of the Advisory Action.

## REMARKS

An Advisory Action was mailed December 18, 2002 in the above referenced case. The Advisory Action rejects Claim 1 on the grounds that a prior amendment had introduced new matter.

Advisory Action is Improper

Applicant asserts that the Advisory Action is improper for the following reasons:

(1) The application is not under and has never been under Final Rejection. Advisory Actions are designed to give guidance to Applicants after filing incomplete responses to Final Office Actions. MPEP 706.07(f) and MPEP 714.13. Further, reference to the PAIR information system confirms that the application is not currently under any rejection, and that the most recent Office Action was mailed February 12, 2002. A copy of the PAIR printout is enclosed.

(2) The Advisory Action rejects the Amendment of October 16, 2002 as submitting new matter. The Amendment of October 16, 2002 (dated October 9, 2002) submitted a

In re: Pugh, et al.

Appl. No.: 09/601,028

Filed: September 18, 2000

Page 2

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substitute Abstract after a telephone request by the Examiner to do so. The Abstract was copied, almost verbatim, from PCT/CA98/00046. The instant application claims priority from PCT/CA98/00046, and a copy of the substance of the Abstract is found on the PCT publication cover sheet originally filed with the application. Information copied directly from the priority document into the instant application can not be considered new matter.

(3) By rule, alleged new matter introduced into the specification is to be rejected as new matter. However, new matter rejections are inappropriate for alleged new matter added only to the claims of an application. MPEP 608.04. Therefore, Claim 1 may not properly be rejected on the grounds of new matter.

**Request by Applicant**

For the reasons stated above, Applicant respectfully requests that the Advisory Action be withdrawn and that the application be allowed.

In the alternative, Applicant requests that the Advisory Action be withdrawn and that an Official Action be issued which particularly addresses any remaining grounds of rejection.

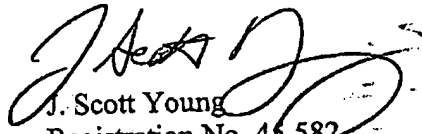
In anticipation of any further new matter rejections, Applicant points to page 3, lines 28-31, of the application which describes a biomaterial compound comprising calcium, oxygen, and phosphorous, wherein at least one of the elements is substituted with an element having an ionic radius of approximately 0.1 to 1.1 Å. Thus, the application is enabled for the substitution of calcium, oxygen, or phosphorous with an element having an ionic radius within the entire range of approximately 0.1 to 1.1 Å.

In re: Pugh, et al.  
Appl. No.: 09/601,028  
Filed: September 18, 2000  
Page 3

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It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

  
J. Scott Young  
Registration No. 46,582

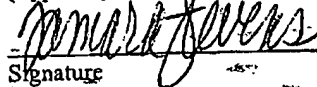
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2/21/03

PAIR Page

Page 1 of 2

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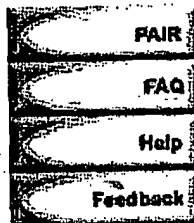
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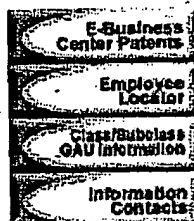
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**PATENT APPLICATION INFORMATION RETRIEVAL**

Other Links



Search results for application number: 09/601,028			
Application Filing Date:	09-18-2000	Class / Sub-Class:	424/426.000
Issue Date of Patent:		Location:	TC-4600 CENTRAL I 3C10
Examiner Name:	DEWITTY, ROBERT M	Status:	Advisory Action Ma
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Foreign Priority

Continuity Data

Publication Review

**File Contents History**

Number	Date	Contents Description
29	12-18-2002	Mail Advisory Action (PTOL - 303)
28	12-16-2002	Advisory Action (PTOL-303)
27	10-16-2002	Date Forwarded to Examiner
26	10-11-2002	Supplemental Response
25	08-19-2002	Date Forwarded to Examiner
24	07-16-2002	Response after Non-Final Action
23	07-16-2002	Request for Extension of Time - Granted
22	02-12-2002	Mail Non-Final Rejection
21	02-11-2002	Non-Final Rejection
20	01-08-2002	Information Disclosure Statement (IDS) Filed
19	01-16-2002	Date Forwarded to Examiner
18	01-08-2002	Response to Election / Restriction Filed
17	01-08-2002	Request for Extension of Time - Granted
16	06-27-2001	Mail-Restriction Requirement
15	06-27-2001	Requirement for Restriction / Election
14	05-13-2001	Case Docketed to Examiner in GAU
13	12-19-2000	Case Docketed to Examiner in GAU
12	11-28-2000	Application Dispatched from OIPE
11	11-09-2000	Application Scanned
10	10-06-2000	Released to OIPE
9	10-06-2000	Notice of DO/EO Acceptance Mailed
8	09-18-2000	Applicant 371 Filing Paper Received
7	09-01-2000	Notice of DO/EO Missing Requirements Mailed

6	08-24-2000	371 Application Preexamination Docketing
5	08-24-2000	371 Application Preexamination Docketing
4	08-08-2000	371 Application Preexamination Docketing
3	07-26-2000	Receipt of 371 Request
2	08-08-2000	Correspondence Address Change
1	09-18-2000	Initial Exam Team nn

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